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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,934	06/06/2001	Matthew G. Donner	INTRASOURCE 3 . 0-002	3522

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EXAMINER

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/874,934	Applicant(s) DONNER ET AL.	
	Examiner Paula W Klimach	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/05/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Celik (6,654,768 B2) in view of Marshall (4,853,882).

In reference to claim 1, the application claims a system for eliminating duplicate mailings that comprises steps for a method instead of components of a system. In order to continue prosecution, the system claimed will be read as a method consisting of the listed steps.

In reference to claims 1, 10, and 12, Celik discloses a method and system for storing information in a computer system and retrieving the information from the computer system (abstract). The method including processing the lists from each maintainer (user PC) through a computer software program that establishes a standard format to remove nonconforming addresses (column 6 lines 1-18), applying a key code identification number from said software to identify the source of each record (column 5 lines 1-17), transmitting the processed recorded data to a central merge/purge processing operation, processing the coded recorded data through the to remove duplicate information (part 16 and column 6 lines 1-18), retransmitting the purged recorded output lists data back to the lists maintainers, and processing the purged output data to match back unduplicated match codes to the original lists of names and addresses (column 8 lines 58-61).

However Celik does not disclose applying a match code algorithm from said software to assign a match code to each record of names and addresses on each list. Although Celik discloses providing the user with the updated contacts, Celik does not expressly disclose transmitting mailings from the list maintainers to the purged lists of names and addresses.

Marshall discloses a system and method for protecting against redundant mailings compile mail listings (abstract). The system assigns match code to each record of names and addresses on each list (column 4 lines 1-50). In addition Marshall discloses transmitting

Art Unit: 2135

mailings from the list maintainers to the purged lists of names and addresses (column 9 lines 55-56 and column 2 lines 30-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the use of the match code to determining if a record is a duplicate as in Marshall in the system of Celik. One of ordinary skill in the art would have been motivated to do this because the use of statistically significant events to identify multiple listings reduces the possibility of redundant mailings and therefore save the cost of multiple mailings.

In reference to claims 2 and 11, wherein the addresses are email addresses (column 6 lines 1-15).

In reference to claim 3, wherein the match code algorithm produces a number for each email address, the number having two parts.

Celik does not disclose using the match code algorithm to produces a number for each email address, the number having two parts.

Marshall discloses using the match code algorithm to produces a number for each email address, the number having two parts (column 5 lines 44-46).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the use of the match code to determining if a record is a duplicate as in Marshall in the system of Celik. One of ordinary skill in the art would have been motivated to do this because the use of statistically significant events to identify multiple listings reduces the possibility of redundant mailings and therefore save the cost of multiple mailings.

Art Unit: 2135

In reference to claim 4, wherein the first part of said number is produced by obtaining the ASCII value for each character of the email address, dividing the ASCII value by the character position in the entire string of characters, and storing the first six decimal positions.

Celik does not disclose using a match code.

Marshall discloses using the match code wherein the first part of said number is produced by obtaining the ASCII value for each character of the email address, dividing the ASCII value by the character position in the entire string of characters, and storing the first six decimal positions (column 5 lines 44-46).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the use of the match code to determining if a record is a duplicate as in Marshall in the system of Celik. One of ordinary skill in the art would have been motivated to do this because the use of statistically significant events to identify multiple listings reduces the possibility of redundant mailings and therefore save the cost of multiple mailings.

In reference to claim 5, wherein the second part of said number is produced by obtaining the ASCII value for each character of the email address, dividing the ASCII value by that value plus one, and storing the first six decimal positions.

Celik does not disclose using a match code.

Marshall discloses using the match code wherein the second part of said number is produced by obtaining the ASCII value for each character of the email address, dividing the ASCII value by that value plus one, and storing the first six decimal positions (column 5 lines 44-46).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the use of the match code to determining if a record is a duplicate as in Marshall in the system of Celik. One of ordinary skill in the art would have been motivated to do this because the use of statistically significant events to identify multiple listings reduces the possibility of redundant mailings and therefore save the cost of multiple mailings.

In reference to claim 8, wherein each of the lists are retransmitted to each respective list maintainer (Fig. 2B).

In reference to claim 9, wherein match and identification information is supplied to the merge/purge operation without supplying actual address data (Fig. 2B).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2135

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the use of the match code to determining if a record is a duplicate as in Marshall in the system of Celik. One of ordinary skill in the art would have been motivated to do this because the use of statistically significant events to identify multiple listings reduces the possibility of redundant mailings and therefore save the cost of multiple mailings.

In reference to claim 6, wherein the final number is a result of the combination of the first and second parts.

Celik does not disclose using a match code.

Marshall discloses using the match code wherein the final number is a result of the combination of the first and second parts (column 5 lines 44-46).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the use of the match code to determining if a record is a duplicate as in Marshall in the system of Celik. One of ordinary skill in the art would have been motivated to do this because the use of statistically significant events to identify multiple listings reduces the possibility of redundant mailings and therefore save the cost of multiple mailings.

In reference to claim 7 wherein the merge/purge operation provides a plurality of purged output lists.

Celik does not disclose the merge/purge operation provides a plurality of purged output lists.

Marshall discloses the merge/purge operation provides a plurality of purged output lists (Fig. 2).


Application/Control Number: 09/874,934

Page 8

Art Unit: 2135

PWK

Monday, November 29, 2004



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